REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the remarks herewith, which place the application into condition for allowance.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 143-148 are currently pending.

II. REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 143-148 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 5,148,154 to Mackay et al. (hereinafter, merely "Mackay") in view of U.S. Patent No. 5,537,528 to Takahashi et al. (hereinafter, merely "Takahashi") and further in view of U.S. Patent No. 5,644,740 to Kiuchi.

Applicants respectfully traverse these rejections for at least two reasons.

A. THE CITED REFERENCES FAIL TO TEACH EVERY ELEMENT RECITED IN THE CLAIMS

Independent claim 143 recites, *inter alia*:

"user interface means for displaying and controlling graphical user interfaces corresponding to processing performed by said edit module, said composite processing module, and said special effect module; the graphical user interfaces including a clip tree window for graphically displaying said tree structure for said plurality of clips;

. . .

wherein said clip tree window displays a clip name for each clip in said tree structure indicating whether the clip is a material clip or a resultant clip." (emphasis added).

The Office Action cites Kiuchi for disclosing this element. Specifically, it is stated on page 3 of the Office Action of July 24, 2006, "Kiuchi teaches a system of displaying information in a hierarchical tree window indicating the type of information contained within the node (Kiuchi, FIG. 17; col. 16, lines 13-25)." (emphasis added). The user-defined "information contained within the node" of Kiuchi is just inapposite to the present invention as discussed below.

Kiuchi discloses a method for a user to locate information in a knowledge-base through a hierarchical display. In a hierarchical knowledge-base, concepts are linked together in a "is-a" relation and a "part-whole" relation. Col. 1, lines 45-64. Each concept can have multiple "is-a" relations and multiple "part-whole" relations. In the knowledge-base, items are expressed in terms of two concepts and one relation, *i.e.*, binary relation. Col. 2, lines 6-11.

The Kiuchi method classifies concepts (data) on the "is-a" relation defined in advance and on a relation (attribute) appended to them by the user, allowing the user to alter the hierarchical tree to meet the user's intention. Col. 4, line 65 to col. 5 line 8. The user specifies a relation (attribute) as a classification representative node on a concept tree of is-a relation to re-define a taxonomic system of concepts. The classification representative node is named by the user, *e.g.*, "company classified by seat." By selecting the classification representative node, the user can view the taxonomic system. Col. 12 lines 10-22 and FIG. 1.

This is just unrelated to the present application element, "displays a clip name for each clip in said tree structure indicating whether the clip is a material clip or a resultant clip."

The Office Action points to Kiuchi FIG. 17 and col. 16, lines 13-25 as reading on the present application's display of a clip name and indicating whether the clip is a material clip or a

resultant clip." This citation is taken out of context and results in a misinterpretation of Kiuchi. Applicants realize that hierarchical tree structures may have labels. In Kiuchi, the knowledge-base is arranged in a hierarchical structure; the nodes identify relations between concepts a subset of which are selected by a user. The nodes enable a user to select subsets of conceptual relationships. FIG. 17 is derived from FIG. 16 wherein "person" and "company" are added as conceptual nodes and the rearranged according to their sub-concepts.

In contrast, the present invention the clips are arranged in the hierarchical structure according to the type of clip. There are at least two types of clips in the hierarchy: material clips and resultant clips. "Material clips" are audio/video material produced by only cutting out from the source video data. "Resultant clips" are material produced by editing the material clips. In the present invention, the clip name identifies whether the clip is a material clip or a resultant clip. The type of clip and, therefore, the clip name is not user-defined nor does the clip name alter the relationship between clips. Indeed, the clip name is a result of the type of clip. The clip name is a necessary result of the type clip, not from a user-defined relationship as in Kiuchi.

Claim 143 is patentable over Mackay, Takahashi and Kiuchi because those references taken alone or in combination do teach or suggest each and every element recited in the claim as discussed above.

For reasons similar or somewhat similar to those described above with regard to independent claim 143, independent claim 146 is also believed to be patentable.

B. NO MOTIVATION TO COMBINE THE CITED REFERENCES

As discussed by the Court of Appeals for the Federal Circuit, a proper conclusion of obviousness under 35 U.S.C. 103 requires that there be some motivation in the prior art that suggests the claimed invention as a whole:

> "[A]n Examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." [Citations omitted] To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show motivation to combine the references that create the case of obviousness."

In re Rouffet, 149 F.d3 1350, 1357; 47 U.S.P.Q. 2d (BNA) 1453, 1457-1458 (Fed. Cir. 1998).

As further explained by the Federal Circuit:

> "Our case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q. 2d (BNA) 1614, 1617 (Fed. Cir. 1999) "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight." *Id.*

The Office Action asserts the just the sort of hindsight that is impermissible. The Office Action of July 24, 2006, on page 3, states the motivation to combine references as, (1) "[i]t would have been obvious . . . to include Takahashi's teaching with MacKay's system in order to provide access to clips for easier and faster editing," and (2) "[i]t would have been obvious . . . to

include Kiuchi's teaching with the system of MacKay and Takahashi in order to provide access to clips for easier and faster editing."

It is Applicant's invention to combine the recited functions. The referenced motivations to combine come from the Applicant's own disclosure **not** from the cited references. The Applicant's disclosure cites the combination of elements as, (1) "the edit work can be performed easier and higher in speed as compared with the conventional one" Publ. App. par. [0362], and (2) "[t]he attribute of clip is data for identifying whether the clip is only a material clip or the clip is a resultant clip . . . [t]he clip name is a name for identifying the clip." Publ. Appl. pars. [0233]-[0234].

Thus, the motivations to combine cited in the Office Action come from the Applicant's own disclosure. It is the very essence of hindsight to take Applicants invention as a blueprint for finding the stated features and then asserting it would be obvious to make the combination absent some motivation that is in the references.

What is lacking from the combination of the references is a teaching, suggestion or motivation, that comes from the references themselves, or from the problem to be solved, to combine the respective teachings to arrive at the applicants' claimed invention.

Hence, there is no motivation to combine in the references to combine those references to achieve the Applicants' invention.

III. DEPENDENT CLAIMS

The other claims are dependent from one of the claims discussed above and are therefore believed patentable for at least the same reasons. Because each dependent claim is also deemed

to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

CONCLUSION

Claims 143-148 are in condition for allowance. In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference, or references, it is respectfully requested that the Examiner specifically indicate those portions of the reference, or references, providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicants respectfully request early passage to issue of the present application.

Respectfully submitted,

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